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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,883	03/13/2001	Junichi Umehara	9366/8001	1834
757	7590	05/19/2005	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 05/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,883

Applicant(s)

UMEHARA, JUNICHI

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's response to Office action of October 4, 2004, received on 2/7/2005 is acknowledged and entered. Claims 11-34 are withdrawn and claims 36-41 are canceled. Currently claims 1-10 and 35 are pending for examination.

Response to Arguments

2. Applicant's arguments filed on 2/7/2005 have been fully considered but they are not persuasive. The applicant argues (see Remarks, page 8, lines 7-23) that the cited prior art of Polash does not teach receiving of electronic information by a user printing device and printing the electronic information on a medium because the act of downloading the electronic information to a computer terminal is distinguishable from the act of printing the electronic information on a medium. The examiner respectfully disagrees for the following reasons:

(a) The prior art in Polash, as cited in the previous office action discloses the same embodiment as construed by the applicant, see below:

page 3, lines 22-28, "***In the preferred method of the present invention, electronic information is purchased online by the end user by first selecting the electronic information to be recorded from an electronic database. The selected information may then be sampled by audio and/or visual means. The end user then pays for the selected electronic information. The electronic information is then received by a user printing device, which prints the electronic information on a medium such as a CD or DVD.***" , and

page 4, lines 6-17, "***.....The preferred system for online purchasing of electronic information according to the method of the present invention comprises a database for maintaining the electronic information, a user data-processing system for accessing the database, a user printing device for directly receiving and printing the electronic information on to a medium, and an electronic network for interconnecting the database, the user data-***

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processing system, and the user printing device. For example, the electronic database, which may be maintained by a music wholesaler, could contain music by a number of artists in the form digital audio data. The database is accessed by a data-processing system such as computer. Once the end user has selected and purchased the desired digital audio data, the data is recorded on to a medium such as a CD by a user printing device.

"

From the above applicant's disclosure one of an ordinary skill in the art would easily construe that the applicant regards recording of the audio electronic information as printing on electronic medium such as, CD or DVD. The prior art of Polash also teaches the same steps of receiving the audio electronic information and printing it on electronic medium, when downloading the audio electronic information in songs to a computer terminal's hard disk/memory because the hard disk/memory of the computer terminal is also an electronic medium on which the songs are printed/recorded. See Polash, Fig.2 and page 6, line 27-page 8, line 2, :

"As depicted in Figure 2, the page includes a play list 42,, an order control button 46.....The play back list 42 lists all the selections played by the radio-station, and in one embodiment, the web server updates the user's web page in real time so that the song currently being played is highlighted for the user. Optionally, the play list shows the title and the time that the selection was played or will be playing... .. The information can be present for past, present and future and playback can be available of CD samples played in the past and future....A user can activate the playback button to request a sample of a selected song to be downloaded to the terminal 14.....The page 40 can also include the order control 46 that allows the user to order a selection, " .

In view of the foregoing, the rejection of all claims, as submitted in the previous office action are sustainable. This is a Final rejection.

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3 Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Polash (WO 99/18518 published on April 15, 1999).

Regarding claims 1-3, Polash teaches a method for online purchasing of electronic information (see at least abstract, "*The web server can further comprise an interface or connection to a database that indexes music selections to a table of recordings, such as an album, CD or Video, and that further indexes the recording to an audio sample that can be downloaded over the Internet or other computer network to allow a consumer to listen and determine if the downloaded sample relates to the preferred selection of the consumer. Optionally, the web server can include a transaction server for allowing the consumer to purchase the selection or associated CD.*") comprising the steps of:

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a) selecting said electronic information, b) paying for said electronic information, c) directly receiving said electronic information by a user printing device and d) printing said electronic information on a medium, d0 sampling said electronic information and e) selectively mixing and ordering a plurality of selected electronic information (see at least page 6, line 27-pgae 8, line 2, "As depicted in Figure 2, the page includes a play list 42.....The information can be present for past, present and future and playback can be available of CD samples played in the past and future.....A user can activate the playback button to request a sample of a selected song to be downloaded to the terminal 14.....The page 40 can also include the order control 46 that allows the user to order a selection,The transaction server can operate to provide the necessary forms to the consumer and to implement the commercial transaction that allows the consumer to purchase the selection over the network 10.....Optionally, users may buy individual selections via download.....". Note: The computer terminal 14 corresponds to the user's printing device including a medium on which the songs can be downloaded that is printed and the completion of purchase transaction inherently implies making payment for the purchased selection. Please also refer to the detailed analysis in " Response to Arguments" above.).

Claim Rejections - 35 USC § 103

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 4-10 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polash and further in view of Salisbury et al. (US Patent 6,041,703); hereinafter, referred to as Salisbury.

Regarding claims 4-10, Polash teaches a method for online purchasing of electronic information by selectively mixing and ordering a plurality of selected electronic information in the form of songs as analyzed for claims 1-3 above. Polash does not disclose the limitations of claims 4-10. However, in the same filed of printing/recording data on CDs and labeling them, Salisbury suggests all the limitations of claims 3-10, that is : selectively labeling said electronic information, printing a user-selected label on said medium, wherein said label includes a photo/title/video scene/concert information (see at least col.1, lines 31-35, "*The present invention speeds up and improves the steps involved in the manufacturing process for recording and preparing a CD by significantly reducing the number of manual handling steps required to record, verify and print label information on a CD. ... Commercially available compact discs can include some generic pre-printed information on a top surface of the disc. For example, a manufacture of the disc may include an identification mark, logo, or trademark..*" , col.6, lines 1-15, "*Referring to FIG. 4, a top surface of a compact disc 90 is illustrated..... As indicated above, preprinted generic information may be located on commercially available compact discs. This information may be in the form of an image comprising graphics, text, manufacturers identification, logo, trademark, background field, or other types of indicia such as a bar code. For purposes of conciseness, the term "image" is used herein to describe any material provided or printed on a surface of a compact disc and is not limited to textual information, identification, or identifying marks.*").

In view of Salisbury, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Polash to incorporate the

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features of selectively labeling said electronic information, printing a user-selected label on said medium, wherein said label includes a photo/title/video scene/concert information. Doing so enables the users to include additional individualized information on the top surface of the compact disc to identify the data recorded/printed on the CD and/or identify the user who prepared that CD or the user who is going to use it himself, as explicitly suggested in Salisbury (see at least col.1, lines 36-52).

Regarding claim 35, all the limitations are already covered in claims 1-10 and therefore it is analyzed and rejected as being unpatentable over Polash and further in view of Salisbury on the same basis.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

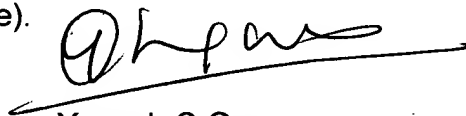
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
May 13, 2005